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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,433	06/07/2001	George Williams	P00044501	8968

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JOHN C. SMITH, ESQ.
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BOCA RATON, FL 33431

EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,433

Applicant(s)

WILLIAMS ET AL.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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EXAMINER'S RESPONSE

1. In response to the application filed 6-7-01 and the preliminary amendment filed 4-22-03, the preliminary amendment has been entered and the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 7-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 9 lacks sufficient structure to provide the location information of the whereby clause.

Claim Rejections - 35 USC § 102 & 103

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in

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order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-2 and 9-10 rejected under 35 U.S.C. 102(b) as being anticipated by Culpepper '807 (US 4021807). Regarding claims 1 and 9 Culpepper '807 discloses a beacon tracking system with a transmitter placed in a packet of currency and activated by removal from a cash drawer to send a homing signal detected by a receiver located with the police to indicate an alarm and location of the stolen object. The transmitter is on a thin polyimide film that is considered to be flexible. See the abstract and col. 4.

8. Claims 3, 5-6, 11, 14-16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Culpepper '807 (US 4021807) as applied above in combination with Norris (US 5689269). Norris discloses an analogous art position detection including a GPS receiver with tracked device to transmit GPS location data that is more accurate than the location method of Culpepper '807 inc cols. 1-2. Note that col. 1 lines 22-43 that directly refers to the Culpepper '807 patent. GPS is included in the abstract and cols. 3-4 to communicate with a device in a vehicle such as a police car.

Regarding claims 3, 5-6, 11, 14-16 and 18-19, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have included in Culpepper '807 transmitting GPS location data in view Norris disclosing this to provide increased accuracy of the location determination in Culpepper '807. Further regarding claim 5. Otto includes batter and antenna and Norris includes GPS output. Further regarding claim 6, Norris includes a programmable processor in the form of an embedded controller 425 with flash memory 402 which would have been obvious in the combination in order to process the GPS data.

9. Claims 4, 7-8, 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Culpepper '807 (US 4021807) as applied above and further in combination with Anders (US 4656463). Anders discloses an analogous art system with a passive transceiver or transponder that may be placed in currency (cols. 7 and 36) can be located with homing triangulation (cols. 4, 24, and 32) and sealed container in col.

4. Regarding claim 4, waterproof would have been obvious in view of the sealed container of Anders to protect the circuitry. Regarding claim 7 and 8, transponder would have been obvious in order to remotely interrogate the tag and different frequencies reduce interference. Regarding claims 10 and 20, Anders discloses homing triangulation as an alternative method of location.

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10. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Culpepper '807 (US 4021807) in combination with Norris (US 5689269) as applied above and further in combination with Anders (US 4656463) as applied above. If transmitting location data of claim 14 is not clear in Anders, then such would have been obvious in view of the combination with Norris as applied to claim 14.

11. Claims 12-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Culpepper '807 (US 4021807) in combination with Norris (US 5689269) as applied above and further in combination with Otto (US 5870029). Otto discloses an analogous art remote mobile monitoring system with currency tracking in col. 1, TDOA in col. 4 and cellular in cols. 2 and 5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included TDOA and cellular in the combination applied above in view of Otto disclosing these as obvious alternative manners to determine location.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Allen (US 3618059), Culpepper '026 (US 5657026), Braddick (US 5952920), Mukogawa (US 6191690) and Grimm (US 2003/0063000) disclose

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currency tracking systems. Fast (US 5479149) discloses a tracking system with a waterproof beacon including GPS receiver and cellular transceiver.


CONTACT INFORMATION

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2600 receptionist whose telephone number is (703) 305-4700.

Facsimile submissions may be sent via fax number (703) 872-9314 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30:-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH
11/30/03


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635